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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/756,247      | 01/08/2001  | Shubhada D. Godbole  | HYS-31CIP           | 5626             |

7590 08/13/2003

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EXAMINER

ALLEN, MARIANNE P

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | <b>Application N .</b> | <b>Applicant(s)</b> |
|------------------------------|------------------------|---------------------|
|                              | 09/756,247             | GODBOLE ET AL.      |
| Examiner                     | Art Unit               |                     |
| Marianne P. Allen            | 1631                   |                     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_ .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) 1-30 are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6)  Other: \_\_\_\_\_

***Election/Restrictions***

Claims 1-30 are pending in the application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 13-16, and 24 drawn to polynucleotides, classified in at least for example, Class 536, subclass 23.1.
- II. Claims 10-12 and 25 drawn to polypeptides, classified in at least for example Class 530, subclass 350.
- III. Claim 17, drawn to antibodies, classified in at least for example Class 530, subclass 387.1.
- IV. Claims 18-20, drawn to a method of detecting a nucleic acids in a sample, classified in at least for example, Class 435, subclass 6.
- V. Claim 21, drawn to a method of detecting polypeptides in a sample, classified in at least for example Class 435, subclass 7.1.
- VI. Claims 22-23, drawn to a method of identifying a binding partner, classified in at least for example, Class 435, subclass 7.1.
- VII. Claims 26-28, drawn to a nucleic acid array, classified in at least for example, Class 435, subclass 6.
- VIII. Claims 29-30, drawn to a method of treating a condition using an agonist or antagonist of a polypeptide, classified in at least for example Class 514, subclass 12.

**Sequence Election Requirement Applicable to All Groups**

In addition, each Group detailed above reads on patentably distinct SEQ ID Numbers. Each sequence is patentably distinct because the sequences are structurally unrelated sequences, and a further restriction is applied to each Group. Applicant must further elect a single SEQ ID NO. for examination. (See MPEP 803.04). It does not appear that any single SEQ ID NO. is completely contained within any other SEQ ID NO.

**Applicant is advised that examination will be restricted to only the elected SEQ ID NO. and should not to be construed as a species election.**

The inventions are distinct, each from the other for the following reasons.

The polynucleotide and polypeptide products of groups I and II can be shown to be distinct, each from the other. Although the polynucleotides and polypeptides are related as the claimed polynucleotide is asserted to encode the claimed polypeptide, they are distinct inventions because they are physically and functionally distinct chemical entities, and the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for processes other than the production of the protein as evidenced by the method of group IV. The antibody product of group III and the nucleic acid array product of group VII are structurally and functionally distinct from each other and from the polynucleotides of group I and polypeptide product of group II. The methods of groups IV-VI and VIII can be shown to be distinct, each from the other, as they have different starting materials, method steps, and goals. These methods can be shown to be distinct from the products of groups I-III and VII, as each of these products is either not used in the methods of groups IV-VI and VIII or has uses unrelated to these methods. For example, the polynucleotides can be used to make the protein or as probes, the polypeptides can be used to make antibodies, the antibodies can be used in methods of purification, the nucleic acid arrays can be used in expression analysis. Each group would require a non-coextensive literature search.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the necessity for non-coextensive literature and sequence searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 7:00 am - 1:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Marianne P. Allen  
Primary Examiner  
Art Unit 1631

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Art Unit: 1631

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August 12, 2003